

ESTTA Tracking number: **ESTTA257664**

Filing date: **12/29/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|------------------------|--|
| Proceeding | 91187611 |
| Party | Defendant LaPene, Jason |
| Correspondence Address | JASON LAPENE 1827 APPALOOSA MILL CT. BUFORD, GA 30519 jason@dwellaatlanta.com |
| Submission | Answer and Counterclaim |
| Filer's Name | Stephen A. Straub |
| Filer's e-mail | sgjdocketing@roylance.com, sstraub@roylance.com |
| Signature | /Stephen A. Straub/ |
| Date | 12/29/2008 |
| Attachments | 91187611 OPP-4 Answer CC.pdf (7 pages)(232789 bytes) |

Registration Subject to the filing

| | | | |
|--------------------|---|-------------------|------------|
| Registration No | 2452089 | Registration date | 05/15/2001 |
| Registrant | DWELL LLC 40 Gold Street San Francisco, CA 94133 UNITED STATES | | |
| Grounds for filing | The registration was obtained fraudulently. | | |

Goods/Services Subject to the filing

| |
|--|
| Class 016. First Use: 1999/06/00 First Use In Commerce: 1999/06/00 All goods and services in the class are requested, namely: Magazines in the field of modern home design |
| Class 042. First Use: 2000/01/00 First Use In Commerce: 2000/01/00 All goods and services in the class are requested, namely: Providing On-line magazine in the field of modern home design |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

-----X

DWELL LLC,

Opposer, :

v. :

Opposition No. 91187611

JASON LAPENE, :

Applicant. :

-----X

APPLICANT'S ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS

Applicant, Jason LaPene, hereby sets forth his Answer, Affirmative Defenses, and Counterclaims to the Notice of Opposition, the subject of Proceeding No. 91187611, filed by Opposer, Dwell LLC, and specifically states as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of Paragraph 1 of the Notice of Opposition, and therefore denies those allegations.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in Paragraph 2 of the Notice of Opposition, and therefore denies those allegations.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of Paragraph 3 of the Notice of Opposition, and therefore denies those allegations.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of Paragraph 4 of the Notice of Opposition, and therefore denies those allegations.
5. Applicant admits the allegations of Paragraph 5 of the Notice of Opposition.
6. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of Paragraph 6 of the Notice of Opposition, and therefore denies those allegations.
7. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of Paragraph 7 of the Notice of Opposition, and therefore denies those allegations.
8. Answering Paragraph 8 of the Notice of Opposition, Applicant admits that the word ATLANTA was disclaimed in Applicant's Application. Applicant denies each and every other allegation of Paragraph 8 of the Notice of Opposition.
9. Applicant denies the allegations of Paragraph 9 of the Notice of Opposition.
10. Applicant denies the allegations of Paragraph 10 of the Notice of Opposition.
11. Applicant denies the allegations of Paragraph 11 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

1. No *likelihood of confusion* exists or is possible for numerous and compelling reasons, and including that Applicant's clearly specialized and uniquely exclusive real estate brokerage services are distinctly different from Opposer's alleged magazines and on-line magazines in the field of modern home design, and Opposer's financially sponsored and arranged exhibitions, seminars and conferences in the field of modern design that no one would

possibly confuse the origin of the respective services, which services obviously are not marketed to the same consumers under circumstances that could give rise to any mistaken belief that the services emanate from the same source. On information and belief, numerous parties have used, applied for, and/or registered marks featuring DWELL, or variants thereof for a broad array of goods and services, including but not limited to Applicant's clearly distinguishable services. The U.S. Patent and Trademark Office ("PTO") has already determined that no *likelihood of confusion* exists to bar the registration and the coexistence of marks featuring DWELL for real estate services, including but not limited to: DWELLWELL, the subject of U.S. Registration No. 3,207,480; URBAN DWELLINGS, the subject of U.S. Registration Nos. 3,134,498; DWELLEX, the subject of U.S. Registration No. 2,922,981; and A DWELLING PLACE REALTY, the subject of U.S. Registration No. 3,351,493 among others. Moreover, the PTO has determined no *likelihood of confusion* exists to bar registration and coexistence of marks featuring DWELL for services related or similar to Opposer's use in the field of home design, including but not limited to URBAN DWELLINGS, LLC, the subject of U.S. Registration No. 3,255,019; DWELLING ARTS INSPIRED HOME AND GARDEN RESOURCES (& design), the subject of U.S. Registration No. 3,389,663; and INNOVATIVE DWELLINGS (& design), the subject of U.S. Registration No. 3,466,334.

2. On information and belief, in view of the contemporaneous registration and/or use by parties of marks featuring DWELL, consumers have been conditioned to distinguish between and among the various uses of DWELL and DWELLING and DWELLINGS among others based on differences in the marks and/or differences in the services.

Accordingly, Opposer's purported mark or marks are not sufficiently strong, famous, or distinctive to bar the registration of Applicant's distinct mark for its highly specialized and exclusive real estate brokerage services.

3. Opposer has not and will not suffer any injury or damage by the registration of Applicant's marks for the services recited in U.S. Trademark Application Nos. 77/502,388; 78/679,781; or 78/679,792.
4. Applicant reiterates that its mark and the potential registration thereof constitutes no false association with Opposer and Opposer's purported marks, or *likelihood of confusion*, or dilution of Opposer's purported marks. While Applicant's highly specialized and uniquely exclusive real estate brokerage services are obviously disparate from Opposer's alleged magazines and on-line magazines in the field of modern home design, and Opposer's financially sponsored and arranged exhibitions, seminars and conferences in the field of modern design, Applicant might be willing to accommodate a restriction of its use to possibly allay Opposer's alleged claims of confusion. No statements in this Paragraph, however, constitute any express or implied request, pleading, consent, or authorization for anyone, including but not limited to the Opposer, the Board and/or PTO, to amend Applicant's recitation of services in U.S. Trademark Application No. 77/502,388.

COUNTERCLAIMS FOR CANCELLATION

1. On information and belief, Opposer committed fraud on the U.S. Patent and Trademark Office by filing a false declaration in connection with the goods within Class 016 of its U.S. Trademark Registration, No. 2,452,089. For example, the specimen filed with the

PTO and published media accounts report that the first use in commerce began during September 2000 rather than June 1999 as claimed by Opposer. On information and belief, Opposer did not use DWELL for magazines in the field of modern home design in U.S. regulated commerce at the time of filing the subject application and had not used in U.S. regulated commerce as of the date claimed therein, thereby committing fraud on the U.S. Patent and Trademark Office.

2. On information and belief, Opposer committed fraud on the U.S. Patent and Trademark Office by filing a false declaration in connection with the services within Class 042 of its U.S. Trademark Registration, No. 2,452,089. For example, the specimen filed with the PTO in conjunction with publicly available records show that the first use in commerce was not before August 2000 whereas Opposer claims such use in commerce began during January 2000. On information and belief, Opposer did not use DWELL for providing on-line magazine in the field of modern home design in U.S. regulated commerce at the time of filing the subject application and had not used in U.S. regulated commerce as of the date claimed therein, thereby committing fraud on the U.S. Patent and Trademark Office.

WHEREFORE, Applicant respectfully requests that this Opposition be dismissed and that the application continue toward registration. Applicant respectfully requests that Counterclaims for Cancellation of U.S. Trademark Registration No. 2,452,089 for DWELL be granted and the Registration cancelled in its entirety. This Answer, Affirmative Defenses, and Counterclaims, is submitted electronically through ESTTA, together with payment by credit card in the amount of \$600.00 in payment of the statutory filing fee.

Respectfully submitted,

Jason LaPene

Dated: December 29, 2008

By: 

Stephen G. Janoski

Stephen A. Straub

Roylance, Abrams, Berdo & Goodman, L.L.P.

1300 19th Street, N.W., Suite 600

Washington, D.C. 20036

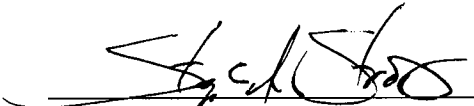
Main Telephone: (202) 659-9076

Facsimile: (202) 659-9344

Attorneys for Applicant

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that an electronic copy of the foregoing Applicant's ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS was filed at the U.S. Patent and Trademark Office through ESTTA, together with associated filing fee by electronic payment, this 29th day of December, 2008.



Stephen A. Straub

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS was served by first class mail, postage prepaid, this 29th day of December, 2008, on attorney for Opposer at the following address:

E. Lynn Perry, Esquire
Perry IP GROUP ALC
4 Embarcadero Center, 39th Floor
San Francisco, California 94111



Stephen A. Straub